

PATENT



Attorney Docket No. GALG/09CO  
Confirmation No. 1497

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence and the enclosures noted herein are being mailed via first class mail, postage prepaid, to the U.S. Patent and Trademark Office, Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 31, 2005.

Gregory F. Ahrens 5-31-05  
Gregory F. Ahrens Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Brian Gallagher	Art Unit:	3711
Serial No.:	10/780,805	Examiner:	Mark S. Graham
Filed:	February 18, 2004	Atty. Docket No.:	GALG/09CO
For:	TRAINING BAT AND METHOD		

Cincinnati, Ohio

May 31, 2005

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION-37 CFR 41.37)**

1. Transmitted herewith is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on November 30, 2004.

2. **STATUS OF APPLICANT**

This application is on behalf of

☐ other than a small entity

☒ small entity

☐ small entity status is requested

☒ small entity status was previously requested and is still proper

3. **FEE FOR FILING APPEAL BRIEF**

Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is:

☒ Small entity \$250.00

☐ Other than a small entity \$500.00

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795.00 OP

4. **EXTENSION OF TIME**

Applicant petitions for an extension of time under 37 C.F.R. 1.136(a) for the total number of months checked below:

<u>Months</u>	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
<u>      </u> one month	\$ . . . . 120.00	\$ . . . . . 60.00
<u>      </u> two months	. . . . . 450.00	. . . . . 225.00
<u>      </u> three months	. . . . 1,020.00	. . . . . 510.00
<u>  X  </u> four months	. . . . . 1,590.00	. . . . . 795.00
<u>      </u> five months	. . . . . 2,160.00	. . . . . 1,080.00
Fee: \$ <u>795.00</u>		

If an additional extension of time is required, please consider this a petition therefor.

5. **TOTAL FEE DUE**

The total fee due is:

Appeal brief fee \$250.00

Extension fee \$795.00

6. **FEE PAYMENT**

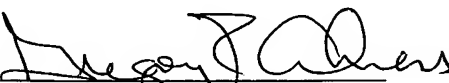
  X   Attached is a check in the sum of \$ 1045.00

       Charge fees totaling \$        to Deposit Account No. 23-3000.

7. **FEE DEFICIENCY**

  XX   Charge any extension fee required or credit any overpayment to Deposit Account No. 23-3000.

WOOD, HERRON & EVANS, L.L.P.

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Attorney Docket No. GALG-09CO  
Confirmation No. 1497



PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* Brian Gallagher

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Appeal No. \_\_\_\_\_  
Application No. 10/780,805

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APPEAL BRIEF

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**APPEAL BRIEF**

**I. REAL PARTY IN INTEREST**

The real party in interest in this application is Brian Gallagher, 6612 Branch Hill Guinea Road, Loveland, Ohio 45104.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**III. STATUS OF CLAIMS**

Claims 1-10 are pending in the Application. All pending claims stand rejected, and are now on appeal.

**IV. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicants' invention is generally directed to a training bat for baseball which has a reduced diameter barrel section to enhance the visual acuity of the user, yet still retains the length and weight combination of a conventional bat. More particularly, with reference to Figs. 1 and 2, the training bat 10 has a barrel section 12, a transition section 14, and a handle section 16. The barrel section 12 has a diameter D which is substantially constant along the entire length of the barrel section 12. The handle section 16 has a diameter d which is substantially constant over the length of the handle section 16. Transition section 14 has a non-constant diameter to accommodate the change in diameter between diameter D of the barrel section 12 and diameter d of the handle section 16.

The training bat 10 is constructed to have a weight and length substantially equivalent to a conventional bat. However, the diameter D of the barrel section 12 is reduced in size relative to the barrel section of a conventional bat. The typical diameter of the barrel section of a conventional bat is 2 3/4" and 2 1/2" for the barrel of a softball bat. Youth bats such as those used in Little League typically have a barrel diameter of 2 1/4". In contrast, the diameter D of the barrel section 12 of the training bat 10 ranges between about 1 1/2" to about 1 3/4", and is preferably 1 5/8". Moreover, as claimed, the barrel diameter D is less than 2 1/4" (claim 1) or is in the range of about 1 1/2" to about 1 3/4" (claim 4).

Because the diameter D of the barrel section 12 is smaller relative to a conventional baseball or softball bat, the training bat must be augmented with additional weight so that its weight is substantially equivalent to that of a conventional baseball or softball bat of like length. To that end, an elongated rod 18 may be inserted into the barrel section 12 and that rod 18 should be chosen such that it replaces both the weight of material eliminated because of the reduced diameter D of barrel section 12 and the weight of material removed to accommodate the rod itself. Using an elongated rod 18 helps to maintain the proper weight distribution along the length of the training bat 10 relative to a conventional bat.

In use, the training bat of the present invention enables a ball player to swing a bat having conventional length and weight dimensions, yet the reduced diameter barrel enhances the visual acuity of the batter when used repeatedly to strike the ball.

## VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,116,926 to Owen (hereinafter *Owen*) in view of U.S. Patent No. 6,050,908 to Muhlhausen (hereinafter *Muhlhausen*). Claims 7-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,280,353 to Brundage (hereinafter *Brundage*) in view of *Muhlhausen*.

## VII. ARGUMENT

### Rejection of Claims 1-6 Under 35 U.S.C. § 103(a)

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Owen* in view of *Muhlhausen*. The Examiner contends it would have been obvious to one of ordinary skill in the art to have provided *Owen*'s bat of smaller diameters to improve hand/eye coordination. Applicant disagrees with this rejection for the following reasons.

The training bat of claims 1 and 4 has a barrel section with a diameter less than that of a conventional bat (i.e., less than 2 1/4" or in the range of about 1 1/2" to about 1 3/4"). Despite the barrel section having a reduced diameter, the overall training bat has a length and a weight which are substantially equivalent to the length and weight of a conventional bat. *Owen* does not teach or even suggest such a training bat.

*Owen* discloses a regulation bat that may vary in diameter at its largest end from 2 1/4 inches to 2 7/8 inches and may vary in length from 29 inches to 36 inches. Column 1, lines 68-70. The *Owen* bat may also vary in weight from 25 ounces to 42 ounces. Column 1, lines 71-72. Essentially, the *Owen* bat has the weight, length, and diameter characteristics of "conventional" bats. Applicant's specification also discloses the weight, length, and diameters of "conventional" bats. For example, the application discloses that the diameter of the barrel section of a conventional bat may range between 2 1/4 inches to 2 3/4 inches. This range of diameters is consistent with the range provided by *Owen*. The *Owen* patent, however, does not teach or suggest the use of a reduced diameter barrel section as recited in claim 1.

The training bat of claims 1 and 4 is intended to develop a batter's accuracy, timing, and visual system. In contrast, the *Owen* bat is intended to develop the wrist and forearm and the

snap of the wrist of the batter. Column 1, lines 15-17. This objective is accomplished by placing weights at the outer portion of the bat while maintaining the characteristics of a “conventional” bat, including barrel section diameter.

*Muhlhausen* discloses a training bat 10 with a handle member 20, a detachable elongated contact surface member 30, and a shock absorber means 26. The elongated contact surface member 30 is detachable from the handle member 20 so that different elongated contact surface members 30 can be used with diameters ranging between 1 inch and 1 ½ inches. Although *Muhlhausen* discloses that elongated contact surface members 30 of varying weights and lengths may be substituted, *Muhlhausen* does not teach or otherwise suggest that the length and weight of the overall training bat 10 is substantially equivalent to the length and weight of a conventional bat.

Thus, one of ordinary skill in the art would not consider modifying the diameter of the barrel section of *Owen* in view of *Muhlhausen* to obtain the bat of claims 1 or 4 because *Owen* is concerned with strength development, not visual acuity. Moreover, if the *Owen* bat were modified as suggested by the Examiner, the *Owen* bat would not function properly. If the barrel section of the *Owen* bat were made narrower, there would be no wood left in the barrel section because the chamber 13 must accommodate the weights 15 in *Owen*. See Fig. 2 of the *Owen* patent. Additionally, if the *Owen* bat were modified in a manner taught by *Muhlhausen*, the bat would have to be multiple pieces. The *Owen* bat may not be modified to make it multiple pieces without destroying the inventive concept of *Owen*, the use of multiple weights inside a chamber at the end of a baseball bat. For these reasons, there is nothing to suggest that the *Owen* bat should be modified in a manner taught by *Muhlhausen*.

Applicant submits that the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself

would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

In other words, to properly combine references to make a *prima facie* case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. *See e.g. ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999).

The rejection is further improper because the Examiner has simply used applicant's claims as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the § 103 rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. *In re Pye & Peterson*, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Regel*, 188 USPQ 136 (CCPA 1975); *In re Avery*, 186 USPQ 161 (CCPA 1975); *In re Imperato*, 179 USPQ 730 (CCPA 1973); and *In re Andre*, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. *W.L. Gore*, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner has impermissibly used hindsight to conclude that it would have been obvious to modify *Owen* in view of *Muhlhausen* to yield the claimed training bat. As discussed above, it is improper to use the claimed invention as a template for modifying a reference in order to render the invention obvious. *See Sensonics, supra*. As such, the Examiner has failed to make a *prima facie* case of obviousness. Accordingly, Applicant submits that independent claims 1 and 4 are patentable over *Owen* in view of *Muhlhausen*. Applicant submits that



dependent claims 2, 3, 5 and 6 are patentable over the combined references for at least the same reasons discussed above with respect to claims 1 and 4. Applicant, therefore, respectfully requests that this rejection be reversed.

#### Rejection of Claims 7-10 Under 35 U.S.C. § 103(a)

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Brundage* in view of *Muhlhausen*. According to the Examiner, *Brundage* discloses a training bat with an elongate rod weight 30 which extends the length of the barrel section, wherein the weight may be varied as desired. *Brundage* does not disclose the diameter of the bat. However, as disclosed by *Muhlhausen*, it is known in the training bat art to make the diameter of the barrel portion as small as 1 to 1 ½ inches to improve hand/eye coordination. In view of *Muhlhausen's* teaching it would have been obvious to one of ordinary skill in the art to have provided *Brundage's* bat of such a smaller diameter as well to improve on hand/eye coordination.

The *Brundage* patent is essentially equivalent to the *Owen* patent discussed in the previous section. Moreover, *Brundage* is directed to a training bat which is designed to have its weight increased by the addition of multiple internal weights to increase a ball player's strength and bat speed. Col. 2, lines 14-15. Similar to the deficiency of the *Owen* patent, *Brundage* does not address or acknowledge the goal of enhancing the visual acuity of the ball player by utilizing a reduced barrel diameter bat having a conventional length and weight dimensions. Thus, the combination of the *Brundage* and *Muhlhausen* references is deficient for precisely the same reasons that the *Owen* and *Muhlhausen* combination was deficient and improper. The arguments set forth in the previous section with respect to *Owen* and *Muhlhausen* are hereby incorporated by reference. Applicant therefore respectfully requests that the rejection of claims 7-10, which depend from claims 1 and 4, be reversed.

#### VIII. CONCLUSION

In conclusion, Applicants respectfully request that the Board reverse the Examiner's rejections of claims 1-10, and that the Application be passed to issue. If there are any questions

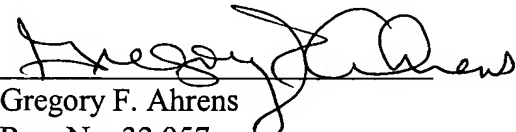
regarding the foregoing, please contact the undersigned at 513/241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

Date: 5-31-05

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**IX. CLAIMS APPENDIX: CLAIMS ON APPEAL (S/N 10/780,805)**

1. (Original) A training bat comprising:

a barrel section having a first diameter, said first diameter being less than 2 1/4 inches;

a transition section having first and second ends, said transition section having a decreasing diameter from said first end to said second end, said first end being operatively connected to said barrel section where said diameter of said first end is substantially equivalent to said first diameter of said barrel section; and

a handle section having a first end with a second diameter, said first end of said handle section being operatively connected to said second end of said transition section where said diameter of said first end of said handle section is substantially equivalent to said second end of said transition section;

wherein said training bat has a length and a weight which are substantially equivalent to the length and weight of a respective conventional Little League, baseball, or softball bat.

2. (Original) The training bat of claim 1, further wherein said barrel section includes a weighted member such that the weight of the training bat is substantially equivalent to that of said respective conventional bats having a length substantially equivalent to the length of said training bat.

3. (Original) The training bat of claim 1, said barrel section made from a material selected from the group consisting of wood, aluminum, aluminum-titanium alloys, beryllium, and plastic composite.

4. (Original) A training bat comprising:

a barrel section having a diameter in the range between about 1 1/2 inches and about 1 3/4 inches; and

a transition section having first and second ends, said transition section having a decreasing diameter from said first end to said second end, said first end being operatively

connected to said barrel section where said diameter of said first end is substantially equivalent to said first diameter of said barrel section; and

a handle section having a first end with a second diameter, said first end of said handle section being operatively connected to said second end of said transition section where said diameter of said first end of said handle section is substantially equivalent to said second end of said transition section;

wherein said training bat has a length and a weight which are substantially equivalent to the length and weight of a respective conventional Little League, baseball, or softball bat.

5. (Original) The training bat of claim 4, further wherein said barrel section includes a weighted member such that the weight of the training bat is substantially equivalent to that of said respective conventional bats having a length substantially equivalent to the length of said training bat.

6. (Original) The training bat of claim 4, said barrel section made from a material selected from the group consisting of wood, aluminum, aluminum-titanium alloys, beryllium, and plastic composite.

7. (Original) The training bat of claim 1 further comprising an elongated rod in a drilled out portion of said barrel section.

8. (Original) The training bat of claim 7 wherein said elongated rod extends the length of said barrel section.

9. (Original) The training bat of claim 4 further comprising an elongated rod in a drilled out portion of said barrel section.

10. (Original) The training bat of claim 9 wherein said elongated rod extends the length of said barrel section.